

REMARKS

Claims 1-8 were pending in the application. Applicants have amended claims 1-8 and added claims 9-40. Therefore, claims 1-40 are pending.

Claims 1-8 have been amended to address formalities, such as proper Markush Groupings. Support for new claim 9 can be found at least in claim 2 as originally filed, and in the specification on page 11, lines 23-26. Support for new claim 10 can be found at least in claim 5 as originally filed, and in the specification on page 11, lines 36-37. Support for new claims 11-17 can be found at least in claim 7 as originally filed, and in the specification on page 2, lines 21-34 and page 10, line 35 through page 11, line 16. Support for new claim 18 can be found at least in claim 8 as originally filed, and in the specification on page 2, lines 13-17 and page 12, lines 11-17. Support for new claims 19 and 20 can be found at least on page 12, lines 6-9, of the specification as originally filed. Support for new claim 21 can be found at least on page 12, lines 12-15, of the specification as originally filed. Support for new claim 22 can be found at least on page 12, lines 17-20, of the specification as originally filed. Support for new claim 23 can be found at least on page 12, lines 20-22, of the specification as originally filed. Support for new claim 24 can be found at least on page 12, lines 24-27, of the specification as originally filed. Support for new claim 25 can be found at least on page 12, lines 27-28, of the specification as originally filed. Support for new claims 26 and 27 can be found at least on page 12, line 36 through page 13, line 2, of the specification as originally filed. Support for new claim 28 can be found at least on page 12, lines 30-33, of the specification as originally filed. Support for new claim 29 can be found at least on page 13, lines 12-13, of the specification as originally filed. Support for new claim 30 can be found at least on page 13, lines 20-22, of the specification as originally filed. Support for new claim 31 can be found at least on page 14, lines 8-11, of the specification as originally filed. Support for new claims 32 and 33 can be found at least on page 14, lines 20-21, of the specification as originally filed. Support for new claim 34 can be found at least on page 14, lines 21-23, of the specification as originally filed. Support for new claim 35 can be found at least on page 14, lines 23-25, of the specification as originally filed. Support for new claim 36 can be found at least on page 14, line 32, of the specification as originally filed. Support for new claim 37 can be found at least on page 15, lines 14-17, of the specification as originally filed. Support for new claim 38 can be found at least on page 15, lines 10-12, of the specification as originally filed. Support for new claim 39 can be found at least on page 15, lines 21-26, of the specification as originally filed. Support for new claim 40 can be found at least on page 12, lines 30-33, of the specification as originally filed. Accordingly, no new matter has been added.

The foregoing amendments to the claims should in no way be construed as acquiescence to any of the Examiner's rejections and have been made solely to expedite prosecution of the above-identified application. Applicants reserve the option to further prosecute the same or similar claims in a separate patent application.

Rejections of Claims 1-8 Under 35 U.S.C. §102(b)

Claims 1-8 have been rejected under 35 U.S.C. §102(b) as being anticipated by WO 97/27821 to Subramaniam ("Subramaniam").

The Examiner asserts that "Subramaniam discloses a prosthetic device having a metal material selected from the defined group, a layer of corresponding hydride material from the defined group and a biomolecule associated therewith."

Applicants respectfully disagree that Subramaniam anticipates the presently claimed invention. As amended, claim 1 is directed to a medical prosthetic device or medical implant made of a metal material, such as titanium, zirconium, tantalum, hafnium, niobium or alloys thereof, or chromium-vanadium alloy. The surface parts of the metal material comprise a layer of hydride material, such as titanium hydride, zirconium hydride, tantalum hydride, hafnium hydride, niobium hydride, and chromium and/or vanadium hydride and one or more biomolecule substances. In contrast, Subramaniam teaches an implant that does not comprise a hydride layer, let alone the hydrides specified in the present claim 1.

In particular, Subramaniam describes an implant comprising a metal material, such as titanium, titanium alloys and stainless steel, which is substantially biocompatible with tissue of the human body. An organic coupling agent, which comprises a reactive group, is carried on the surface of the foreign body. A bioactive agent is then bonded to reactive group on the organic coupling agent by a chemical reaction. Thus, the Subramaniam implant does not comprise a hydride layer.

The Examiner also maintains that "[c]laim 8 is dependent on claim 1 and therefore the claim is interpreted as a product by process claim. Therefor(e), the product is disclosed by Subramaniam and does not require the specific method steps of claim 8." Applicants respectfully disagree and are confused by the Examiner's statement. Claim 1 is a product claim. Claim 8 is a process claim that, prior to being amended herein, was a process of making the product. Therefore it is unclear why the Examiner states that claim 8 is a product-by-process

claim. Moreover, the Examiner appears to acknowledge that the method steps of claim 8 are not taught or suggested by Subramaniam. Therefore, claim 8 is not anticipated.

Notwithstanding, without acquiescing to the rejection and in the interest of expediting prosecution of the present application, Applicants have amended claim 8 such that it no longer depends from claim 1, and more clearly sets forth the steps of preparing the metal material by submitting it to electrolysis with a hydride material in the presence of at least one biomolecule to form the device or implant containing the biomolecule associated with the hydride material.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections of claims 1-8 under U.S.C. §102(b).

CONCLUSION

In view of the above amendment, Applicants believe the pending application is in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone call would expedite the prosecution of this case, the Examiner is urged to call Elizabeth A. Hanley, Esq. at (617)227-7400.

Applicant believes no fee is due with this statement. However, if a fee is due, please charge our Deposit Account No. 12-0080, under Order No. AWZ-003RCE from which the undersigned is authorized to draw.

Dated: February 22, 2005

Respectfully submitted,

By 

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